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1940 DUKE STREET
ALEXANDRIA, VA 22314

In re Application of	:
Paul A. Jones et al	:
Serial No.: 10/031,339	: PETITION DECISION
Filed: May 17, 2002	:
Attorney Docket No.: 217926US0PCT	:

This is in response to the combined petition and response under 37 CFR 1.181, filed August 26, 2004. The delay in acting on this petition is regretted but was occasioned by applicants' titling the petition as a response rather than solely as a petition.

BACKGROUND

A review of the file history shows that this application was filed with six claims directed to a composition and use of the composition for treatment of brain disorders. In a first Office action mailed September 22, 2003, the examiner rejected, or objected to, all claims for one or more of the following reasons: 37 CFR 1.75(c) as of improper dependent form; 35 U.S.C. 101 for use of a composition without any steps being set forth; 35 U.S.C. 112, first paragraph, as containing subject matter not described in the specification; 35 U.S.C. 102(b) as anticipated by Kelly et al.

Applicants replied on March 22, 2004, canceling claims 1-6 and adding claims 7-11 and pointing to support for the claims in the previous claims and specification. The various rejections were also responded to appropriately.

In response, the examiner mailed out a letter, on August 9, 2004, stating that the amendment was non-responsive in that the claims were now directed to an invention not previously claimed. A subsequent telephone interview with the examiner on August 13, 2004, did not result in the examiner withdrawing the letter of non-responsiveness. This petition and response followed on August 26, 2004.

DISCUSSION

Applicants petition the examiner's action on the grounds that the now claimed invention is a species or subgenus of the originally claimed genus and the examiner has no right to hold the response which narrows the broad claims non-responsive.

A review of the original claims shows that claim 1 is directed to use of a specific compound for making a neuroprotective agent; claim 2 to a method of preventing acute or chronic cerebral neurodegenerative diseases by administering the compound of claim 1; claim 3 is to a pharmaceutical composition of claim 1 for preventing or treating cerebral neurodegenerative diseases; claim 4 specifies the diseases as brain damage caused by ischemia or hemorrhage; claim 5 specifies the disease as cerebral infarction; and claim 6 is directed to use of the compound of claim 1 for treating or preventing acute or chronic cerebral neurodegenerative diseases.

The claims added in the response to the first Office action which replace the original claims shows that claim 7 is directed to a method of treating or preventing brain damage caused by ischemia or hemorrhage by administering a specific compound; claim 8 defines ischemia or hemorrhage as cerebral infarction; claim 9 defines further types of damage; claim 10 limits damage to that caused by stroke; and claim 11 to damage from chronic stroke.

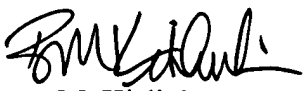
As can be seen from a comparison of the scope and content of the claims, original claim 2 is directed to a genus of neurodegenerative diseases, but claims 4 and 5 further limit the genus to specific types of diseases. The added claims are limited to the same types of specific neurodegenerative diseases as set forth in the original dependent claims. For the examiner to contend that the claims are now directed to a different invention than originally claimed would be tantamount to the examiner denying applicants the opportunity and prerogative of amending their claims by narrowing them to a preferred embodiment in order to, hopefully, avoid the prior art and have them found allowable. The action was further inappropriate since the first Office action treated and rejected claims of similar scope and content. The examiner's action in holding the newly presented claims non-responsive more than four months after the response was filed is also inappropriate. Such holding should be made as soon as possible after a response is filed so that applicants can more timely correct such response where necessary.

DECISION

The petition is **GRANTED**. The response filed by applicants on March 22, 2004, is considered fully responsive. The Notice of Non-responsive Amendment is withdrawn.

The application will be forwarded to the examiner for further action thereon not inconsistent with this decision.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number 571-273-8300.



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